

### REMARKS

The present response relates to the Office Action in the above-identified application mailed on March 27, 2003. Claims 1-22 are pending. Claims 1-13 are rejected. Applicant cancels Claims 14-22 due to an election/restriction requirement, and respectfully requests reconsideration and favorable action in this case.

#### **Election/Restriction Requirement**

During a telephone conversation with Examiner Chakrabarti on January 27, 2003, the Examiner required an election between Claims 1-13, drawn to hybrid gene, Claims 14-16, drawn to method of protein expression, and Claims 17-22, drawn to transformation of cells. Applicant hereby cancels Claims 14-22 without prejudice or disclaimer and elects that the cancelled claims are subject to the filing of a divisional application.

#### **Rejections under 35 U.S.C. § 103**

Claims 1-6, and 9 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hong et al. (Proceedings of the National Academy of Sciences, May 1996, Vol. 93, pages 4948-4952) (hereinafter "Hong") in view of U.S. Patent 6,083,727 issued to Guegler et al. (hereinafter "Guegler").

Claim 7 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of Guegler, and further in view of U.S. Patent 6,492,143 issued to Reed et al. (hereinafter "Reed").

Claim 8 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of Guegler, and further in view of U.S. Patent 6,432,692 issued to Bradfield et al. (hereinafter "Bradfield").

Claim 10 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of Guegler, and further in view of U.S. Patent 5,336,609 issued to Oberto et al. (hereinafter "Oberto").

Claim 11-12 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of Guegler, and further in view of U.S. Patent 5,707,862 issued to Miyanohara et al. (hereinafter "Miyanohara").

Claim 13 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Hong in view of Guegler, and further in view of U.S. Patent 6,277,639 issued to Passmore et al. (hereinafter "Passmore"). Applicant respectfully traverses this

rejection and submits that Hong fails to disclose several limitations of Claim 1 and dependent Claims 2-13.

Specifically, although the Examiner alleges that Hong discloses "c) a DNA sequence encoding at least one common peptide placed 3' to the multiple cloning site, wherein the common peptide encoding sequence does not contain a translation initiation codon", Applicant cannot find these limitations in Hong.

First, Hong does not appear to disclose placement of a common peptide sequence 3' of the multiple cloning site. The plasmids described in both the Abstract and the Materials and Methods, including the Construction of Recombinant Vectors section of Hong all appear to be normal plasmids in which the common peptide sequence is placed 5' of the multiple cloning site. The Specification of the present application explains in great detail the various reasons why placement of the common peptide sequence 3' of the multiple cloning site may lead to different capacities and effects in the encoded protein than placement of the common peptide sequence 5' of the multiple cloning site. Therefore, the placement of the common peptide sequence 3' of the multiple cloning site in the present invention is not obvious in light of the placement of the common peptide sequence 5' of the multiple cloning site as disclosed in Hong.

Second, Hong does not appear to utilize a common peptide sequence that lacks a translation initiation codon. As noted above, all of the plasmids in Hong appear to be normal plasmids with the common peptide sequence 5' of the multiple cloning site. Although a translation initiation codon is not explicitly recited, the common peptide sequence most likely contains one in order to allow expression of the hybrid protein.

Accordingly, nothing Applicant can find in Hong teaches or suggests the two above limitations. None of the other references cited appear to teach or suggest these limitations. If the Examiner believes that Hong teaches or suggests both a 3' placement of the common peptide sequence relative to the multiple cloning site and omission of a translation initiation codon from the common peptide sequence, Applicant respectfully requests a more detailed citation of the relevant portion of the text and/or a more thorough explanation of the logic used to reach such a conclusion. Absent such a more detailed Explanation, Applicant cannot address the present rejection.

Applicant submits that Hong alone or in combination with the other cited references fails to teach or suggest the two above limitations of Claim 1 and dependent Claims 2-13 and therefore requests allowance of all pending claims.

The discussion above of only two limitations of Claim 1 not taught or suggested by Hong is not meant to imply that other limitations of Claims 1-13 are taught or suggested by Hong alone or in combination with the other cited references. Applicant has not addressed other possible inadequacies of the references because Applicant believes the deficiencies in Hong are adequate to overcome the present rejections.

### CONCLUSION

Applicant submits a Change of Correspondence Address.

Applicant believes Claims 1-13 are now in condition for allowance. Applicant requests a three-month extension of time and accordingly enclose the fee specified in 37 C.F.R. 1.17(a)(4).

Applicant encloses a check in the amount of \$930.00 required for a three-month extension of time under 37 C.F.R. 1.17(a)(4). Should any additional fees be due as a result of this amendment or for any other reason during prosecution of this application, the Commissioner is hereby authorized to charge the payment of any required fees to Deposit Account No. 50-2148.

Respectfully submitted,

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